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15 the response provided by the applicant has been read and given careful consideration. The objections to the specification are withdrawn in view of the amendments made. Responses to the arguments raised by the applicants are provided after the rejection they are directed to. The rejection made under 35 U.S.C. § 112, second paragraph is withdrawn in view of the arguments raised. The rejection based in part upon Conte et al. '29, Bowers et al. '841 or Zeevi et al. '014 are withdrawn in view of the arguments, due to lack of proper motivation to combine.

16 Claims 1-7 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the use of a support for the photosensitive layer, since these materials are not taught to be self-supporting. See M.P.E.P. §§ 706.03(n) and 706.03(z).

The restriction of the claims to photosensitive materials is withdrawn in view of the arguments presented by the applicant. The applicant argues that the recited "lithographic printing plate precursor" includes a support, citing portions of the specification. This is not found persuasive in view of the examples given on page 9 in lines 27-32 which only recite the

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photosensitive or heat mode recording layers. The rejection is maintained for this reason.

17 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

18 Claims 1-6 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-8 of copending application Serial No. 08/227073. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

The only difference is in the substitution of "scan-wise exposing" in the instant claims in place of "image-wise exposing".

The applicant states that terminal disclaimer will be filed. A terminal disclaimer has not yet been filed in the instant application, therefore this rejection and the one in paragraph 19 below are maintained.

19 Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending application Serial No. 08/227073 in view of Saikawa et al. '811 or Peterson '762.

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This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Saikawa et al. '811 teaches the use of a laser or LED to expose a diffusion transfer which is developed using an alkaline processing solution. Examples of light sources are disclosed. col 1/lines 60-63, hereinafter 1/60-63, 2/32-42 and 2/55-65)

Peterson '762 establishes that it is known to use a laser to form a lithographic printing plate. The process uses a mixture of a diazo composition with nitrocellulose and carbon black. The carbon black absorbs light converting it heat and heating the nitrocellulose until it combusts, removing it from the support surface.

It would have been obvious to use lasers or LEDs to expose the materials claimed in co-pending application 08/227073, based upon the teachings within the art to expose materials specifically forming lithographic printing plates, such as those provided by Saikawa et al. '811 or Peterson '762.

See above paragraph for a response.

20 The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or

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patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

21 The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

22 Claims 1,4,6 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over either Saikawa et al. '811 or Monbaliu et al. '156, in view of Stoffel et al. (1981).

Monbaliu et al. '156 teaches the use of conventional sources, laser or LEDs for exposing silver diffusion media to form lithographic printing plates. (col 10/line 66-col 11/line 35, hereinafter 10/66-11/35). The processing is described in the abstract and claims as well as the text.

Stoffel et al. '(1981) teaches various techniques for use in scanning and screening images such as photographs and camera images to produce halftone images which are useful with binary output devices such as lithography. (Page 1898/col 1/paragraphs

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1-2). Pages 1907,1908,1915,1916 and tables I & II describe the process of error diffusion and the benefits.

It would have been obvious to one skilled in the art to include frequency modulation screening techniques such as error diffusion taught by Stoffel et al. '(1981) in the techniques of producing printing plates disclosed by either Saikawa et al. '811 or Monbaliu et al. '156 with a reasonable expectation of gaining the benefits taught by Stoffel et al. '(1981), based upon the disclosure of Stoffel et al. '(1981) that this technique is applicable to lithography.

The applicant argues that apart from the fact that lithography covers the computer-to-plate techniques, the use of it with frequency modulation is new and inventive. The applicant admits that Stoffel et al. specifically states that the use of the algorithms described are compatible with lithography, although optimization is not specifically discussed with respect to each. The examiner holds this to support his position, not that of the applicant. Further the penultimate statement cited only points out to one of ordinary skill in the art that proper registration is necessary to avoid tone scale errors. The applicant does not exclude this registration process and it is generally recognized to be important in constructing multicolor images by those in the printing industry. Also the passage cited earlier by the applicant makes it clear that this is an overview

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and some optimization is required for each process it can be used with for it to reach its full potential. The examiner holds that this does not point away from the invention, but reminds one of ordinary skill in the art that these techniques are particularly registration sensitive. The examiner notes that passages cited by the applicant specifically point out the described techniques are general to the processes that they are taught as useful with and not directed to any particular process. The examiner maintains the rejection for the above reasons.

23 Claims 1,4,5 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over Peterson '762, in view of Stoffel et al. '(1981).

It would have been obvious to one skilled in the art to include frequency modulation screening techniques such as error diffusion taught by Stoffel et al. '(1981) in the techniques of producing printing plates disclosed by Peterson '762 with a reasonable expectation of gaining the benefits taught by Stoffel et al. '(1981), based upon the disclosure of Stoffel et al. '(1981) that this technique is applicable to lithography.

See the response provided in paragraph 22 above.

24 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS

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ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

25 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Angebrannndt whose telephone number is (703) 308-4397.

I am normally available between 7:30 AM and 5:00 PM, Monday through Thursday and 7:30 AM and 4:00 PM on alternate Fridays.

If repeated attempts to reach me are unsuccessful, my supervisor may be reached at (703) 308-2417.

Facsimile correspondence should be directed to (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

*mja*

mja 4/10/95

*Charles L. Bowers, Jr.*  
CHARLES L. BOWERS, JR.  
SUPERVISORY PATENT EXAMINER  
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